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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/764,748	01/18/2001	Jonathan E. Lowthert	INTL-0511-US (P10480)	7988
21906	7590	06/01/2005	EXAMINER	
TROP PRUNER & HU, PC 8554 KATY FREEWAY SUITE 100 HOUSTON, TX 77024			DEMICCO, MATTHEW R	
			ART UNIT	PAPER NUMBER
			2611	

DATE MAILED: 06/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/764,748

Applicant(s)

LOWTHERT ET AL.

Examiner

Matthew R. Demicco

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 November 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This action is responsive to an amendment filed 11/01/2004. Claims 1-30 are pending. The prior objection to the drawings is hereby withdrawn in light of the amendment.

Response to Arguments

2. Applicant's arguments filed with respect to Claims 1, 11 and 21 have been fully considered but they are not persuasive. Regarding these claims, Applicant argues that Dedrick fails to disclose a receiver that temporarily replaces content with advertising or that inserts advertising. Applicant further argues that because Dedrick's receiver does not replace content with advertising that there is no identification of or crediting content providers for the inserted advertising.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The Examiner points out that Dedrick is not relied on for teaching the insertion of advertisements at the user's receiver. Dedrick but must be considered in *combination* with Zigmond, who clearly teaches inserting and identifying advertisements at the user's receiver. Dedrick is merely relied upon for the teaching of crediting content providers for advertisements consumed by users. Therefore, in combination with Zigmond, advertisements are identified, inserted, and a credit is subsequently made to the content providers.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1, 9-11, 19-22 and 28-29 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 9-11, 18-19, 21-22 and 9-10 of copending Application No. 09/765,246. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are obvious variations.

Claim 1 of the instant application corresponds to Claim 1 of the '246 application.

Claim 1 differs in that it identifies content and advertising used on the receiver and collects information to enable a credit to content providers for inserted advertising. This is an obvious variation because collecting information and crediting content providers is well known in the art as disclosed by U.S. Patent No. 5,724,521 to Dedrick. Such a modification is desirable in order to increase revenue from advertisers by tracking an ad's airtime and billing accordingly.

Claims 9-10 of the instant application correspond to Claims 9-10 of the '246 application.

Claim 11 of the instant application corresponds to Claim 11 of the '246 application. Claim 11 differs in the same manner as Claim 1 above.

Claims 19-20 of the instant application correspond to Claims 18-19 of the '246 application.

Claim 21 of the instant application corresponds to Claim 21 of the '246 application. Claim 21 differs in the same manner as Claim 1 above.

Claim 22 of the instant application corresponds to Claim 22 of the '246 application.

Claims 28-29 of the instant application correspond to Claims 9-10 of the '246 application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,698,020 to Zigmond et al. in view of U.S. Patent No. 5,724,521 to Dedrick.

Regarding Claim 1, Zigmond discloses a method comprising allowing the use of content on a content receiver (See Figure 5 and Col. 4, Lines 16-24), automatically interrupting the use of the content (Col. 7, Lines 26-29) and enabling the receiver to temporarily replace the content with advertising (Col. 7, Lines 30-36 and Col. 4, Lines 45-52). Zigmond further discloses identifying content used on the receiver (Col. 9, Lines 21-45). What is not disclosed, however, is identifying advertising inserted by the receiver and collecting information to enable a credit to content providers for inserting advertising. Dedrick discloses a method for providing electronic advertisements to users using profiles (See Abstract). Dedrick further discloses monitoring what information is viewed and storing it in a database (Col. 8, Lines 17-27) including what advertisements were watched and for how long (Col. 9, Lines 28-48). Dedrick also discloses charging the advertisers a fee each time the advertisement is consumed by a user (Col. 11, Lines 16-21 and Col. 12, Lines 5-8) and crediting a publisher if, for instance, the ad is associated with the publisher's content (Col. 15, Lines 37-46). This reads on the claimed identifying advertising inserted by the receiver and collecting information to enable a credit to content providers (publishers) for inserting advertising. Dedrick is evidence that ordinary workers in the art would recognize the benefits of monitoring which ads were consumed and charging based on the consumption in a targeting advertising system. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of Zigmond with the monitoring and charging of Dedrick in order to increase revenue from advertisers by tracking an ad's airtime and billing accordingly.

Regarding Claim 2, Zigmond in view of Dedrick disclose a method as stated above in Claim 1. Zigmond further discloses that ads may be selected for playback during the presentation a particular program (Col. 12, Lines 44-56). This reads on the claimed identifying content and advertising based on a time relationship between the content and the advertising.

Regarding Claim 3, Zigmond in view of Dedrick disclose a method as stated above in Claim 1. Zigmond further discloses displaying an ad in relation to the subject matter of the programming (Cols. 12-13, Lines 60-6). After a particular star of a movie appears on a show, an ad for a movie featuring that star may be displayed. This reads on the claimed identifying content and advertising based on the order of playing the advertising and content.

Regarding Claim 4, Zigmond in view of Dedrick disclose a method as stated above in Claim 3. Zigmond further discloses monitoring the times of day programming is watched and the amount of time spent watching (Col. 11, Lines 14-19). This reads on the claimed collecting information about the amount of content selected for play on the receiver.

Regarding Claim 5, Zigmond in view of Dedrick disclose a method as stated above in Claim 4. Zigmond further discloses providing information to a remote processor-based system (Col. 9, Lines 45-55 and Col. 4, Lines 55-67). This information includes the actions of the user before, during and after the ad, channel changes, requests for additional information, and feedback in response to an ad. This reads on the claimed

reporting to a remote processor-based system information about what content was played with advertising.

Regarding Claim 6, Zigmond in view of Dedrick disclose a method as stated above in Claim 5. Zigmond further discloses selecting advertising based in part on the content being played on the receiver (Col. 12, Lines 44-62).

Regarding Claim 7, Zigmond in view of Dedrick disclose a method as stated above in Claim 1. Zigmond further discloses that the receiver is operable to receive television programming in addition to pay-per-view programming and other forms of video content (Col. 6, Lines 13-29). In such a television system, the user is able to choose programming they wish to watch (Col. 11, Lines 16-18). This reads on the claimed receiving a user content selection. Further disclosed is identifying advertising to associate with the content (Col. 11, Lines 31-49).

Regarding Claim 8, Zigmond in view of Dedrick disclose a method as stated above in Claim 1. Zigmond further discloses identifying the content television programming (Col. 11, Lines 8-13 and Col. 12, Lines 60-63) for selecting an advertisement. This reads on the claimed determining a type of the content.

Regarding Claim 9, Zigmond in view of Dedrick disclose a method as stated above in Claim 1. Zigmond further discloses that predetermined times (Cols. 2-3, Lines 67-1) are specified in the video feed for insertion of advertising (Col. 7, Lines 26-29). This reads on the claimed including automatically replacing the content with advertising after allowing content to be used for a predetermined amount of time.

Regarding Claim 10, Zigmond in view of Dedrick disclose a method as stated above in Claim 1. Zigmond further discloses automatically determining at predetermined times whether to replace the content (Col. 7, Lines 26-29).

Regarding Claim 11, see Claims 1 and 5 above. Further, Zigmond discloses a system including computer-readable media having computer-executable instructions stored thereon (Col. 6, Lines 48-55). It is inherent that such a computer-based device has a processor in order to execute the stored instructions.

Regarding Claim 12, see Claim 2 above.

Regarding Claim 13, Zigmond in view of Dedrick disclose an article as stated above in Claim 12. Dedrick further discloses charging the advertiser a fee each time an advertisement is consumed (Col. 11, Lines 16-21) and periodically generating a bill to send to the advertisers (Col. 15, Lines 21-25). Dedrick also discloses charging the advertisers a fee each time the advertisement is consumed by a user (Col. 11, Lines 16-21 and Col. 12, Lines 5-8) and crediting a publisher if, for instance, the ad is associated with the publisher's content (Col. 15, Lines 37-46). This reads on the claimed enabling the receiver to accrue a credit to the provider of content (publisher) that is proximate to the advertisement.

Regarding Claim 14, Zigmond in view of Dedrick disclose an article as stated above in Claim 13. As stated above, a fee is charged to the advertiser for each time the advertisement is consumed by an individual end user (Col. 11, Lines 16-21). Dedrick also discloses charging the advertisers a fee each time the advertisement is consumed by a user (Col. 11, Lines 16-21 and Col. 12, Lines 5-8) and crediting a publisher if, for

instance, the ad is associated with the publisher's content (Col. 15, Lines 37-46). This reads on the claimed enabling the receiver to accrue a credit to the content provider (publisher) based on the amount of content selected for play on the receiver.

Regarding Claims 15-17, see Claims 5-7 above, respectively.

Regarding Claim 18, Zigmond in view of Dedrick disclose an article as stated above in Claim 11. Zigmond further discloses a system wherein the receiver is operable to receive television programming in addition to pay-per-view programming and other forms of video content (Col. 6, Lines 13-29). In such a television system, the user is able to choose programming they wish to watch (Col. 11, Lines 16-18). This reads on the claimed enabling a variety of content to be selected for play at any time.

Regarding Claims 19 and 20, see Claims 9 and 10 above, respectively.

Regarding Claim 21, Zigmond discloses a system comprising a receiver (Col. 6, Lines 48-67) that receives the transmission of content (Col. 7, Lines 1-25). Further disclosed is the ability of the receiver to enable the use of content to be interrupted and temporarily replaced with advertising as stated above. This reads on the claimed "shell". Also disclosed is storage coupled to the receiver storing instructions (Col. 6, Lines 50-61) that enable the receiver to associate advertising with content as stated above. Zigmond in view of Dedrick discloses a receiver enabled to credit a content provider for inserted advertising as stated above.

Regarding Claim 22, Zigmond discloses a system as stated above in Claim 21, wherein the system is a television receiver (Col. 6, Lines 40-44).

Regarding Claims 23-25, see Claims 12-14 above, respectively.

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Regarding Claim 26, see Claim 5 above.

Regarding Claim 27, see Claim 7 above.

Regarding Claims 28 and 29, see Claims 9 and 10 above, respectively.

Regarding Claim 30, see Claim 18 above.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew R. Demicco whose telephone number is (571) 272-7293. The examiner can normally be reached on Mon-Fri, 9am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Grant can be reached on (571) 272-7294. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.


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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



mr.d

May 16, 2005



CHRIS GRANT
PRIMARY EXAMINER